

1. The application discloses and claims new diphosphines (and ways for making them), their metal complexes and use of the metal complexes for enantioselective synthesis.

Thus claimed are:

- a) diphosphine ligands (compound claims),
- b) process for making these ligands a),
- c) metal complexes made from these ligands a), and
- d) “use” (process for preparing) of the metal complexes c) as catalysts.

The claims were considered new and inventive (unobvious) in the international phase.

The common technical feature is the diphosphine.

2. The PCT-IPER did not raise an “a priori” non-unity objection (an “a posteriori” objection was ruled out as the invention was considered new in view of the prior art).

3. The Examiner nevertheless surprisingly raised an “a priori” non-unity objection.

4. Rule 13.2 PCT requires that the technical features define a contribution over the prior art for each of the inventions, thus providing a single inventive concept as required by Rule 13.1 PCT.

5. The Examiner did not provide any arguments as to why the given groups do not provide a contribution over the prior art according to Rule 13.2 PCT. For example the statement “the claims of group II [obviously the Examiner meant Group I and not II], III and IV belongs to divergent structural compounds” cannot be seen as an argument as to why each group lacks a contribution over the prior art. Why are there “divergent structural compounds” as they all have the ligands a) as a same technical feature in common?

6. The Examiner states that “(i) the process for preparing compound of claim can be made using materially different process”.

This is in conflict with the “PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES”. See Part III, Chapter 10, dealing with “Unity of Invention” (page 75ff), wherein it is stated (page 77) under point 10.12 that it is permitted “(i) in addition to an independent claim for a given product, an independent claim for a process specifically adapted for the manufacture of the said product, and an independent claim for a use of the said product ...”. (Emphasis added)

Under point 10.13 (page 77) the guidelines further state that "10.13 Thus, a process is considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process." (Emphasis added)

7. Conclusively neither the reason given under point (i) nor the reason under point (ii) of the restriction requirement is proper. The Examiner is therefore requested to withdraw the restriction requirement. However, in case he maintains the restriction requirement then he should base his arguments strictly on the rules of the PCT by properly applying these rules and the PCT guidelines. This could especially be expected from an Examiner if he deviates from the opinion of the international authorities.

Although Applicants have traversed the requirement for restriction and election of species based on the foregoing considerations, they still reserve their rights under 35 U.S.C. §121 to file a divisional application for the non-elected subject matter.

Action on the merits is requested.

Respectfully submitted,

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